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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,661	11/21/2003	Conrad A. Walters	18360/260051	1322
826	7590	04/03/2007	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/719,661	WALTERS ET AL.
	Examiner Robert M. Pond	Art Unit 3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 December 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,5-13 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,5-13 and 20-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/19,21/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Response to Amendment***

The Applicant amended all independent claims and based arguments on the amended language. Claims 2-4 and 14-19 were canceled. All pending claims 1, 5-13, and 20-30 were examined in this final office action necessitated by amendment.

### ***Response to Arguments***

Applicant's arguments filed 19 December 2006 have been fully considered but they are not persuasive. Tsunenari was withdrawn as necessitated by amendment in favor of Williams and Hauser. Arguments pertaining to Tsunenari are moot. Both Williams and Hauser pertaining to the same field of endeavor as the Applicant's claimed invention and both provide solutions to solving the same problems and the Applicant's claimed invention.

### ***Specification***

1. Second notice: Reference to Figs. 12 and 13 are omitted from Detailed Description of Drawings in the specification. Correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 1, 5-10, 12, 13, and 20-30 are rejected under 35 USC 103(a) as being unpatentable over Williams (US 2002/0032612).**

Williams teaches a returns system that is configured and programmed to provide a plurality of online and physical merchant stores with a fast, simple, and convenient way for online customers to return merchandise purchased from that store from within the online store (see at least abstract; pare 0016; 0192).

Williams further teaches:

- establishing an interface system that is capable facilitating communication with said plurality of merchant computer systems and said at least one carrier computer system via a computer network; returns system connects a plurality of merchant computer to at least one carrier computer system over the Internet (see at least Fig. 1; 0134-0136).
- receiving at said interface system a customer return request from one of said plurality of merchant computer systems, said customer return request including a merchant identifier; merchant setup account with merchant rules for processing customer returns; merchant account

number used to identify the merchant associated with the return request from a customer (see at least 0017; 0021; 0129; 0183; 0541).

- querying a database containing a plurality of returns rules to select one or more returns rules associated with said customer return request from the plurality of returns rules, the selection of said one or more returns rules being dependent on said merchant identifier; queries database for return rule(s ) dependent upon merchant (see at least Fig. 5d (754-764); 0168; 0230; 0247)
- applying said one or more selected returns rules to said customer return request to determine whether said request is authorized, the authorization of said request being dependent on which of the plurality of returns rules has been selected; applies a merchant's returns policy; authorizes return (see at least 0023; 0230; 0253).
- assembling a return service request based at least in part on said customer return request; as noted above.
- transmitting said return service request to said at least one carrier computer system; notifies carrier about the pickup request (see at least 0412-0417).
- Williams teaches all that is noted in this rejection under 35 USC 103(a) and teaches a) the system of Williams storing carrier information unique to each carrier in a carrier database, b) client-server architecture with databases distributed across the communication network, and c) the

returns system relying upon carrier shipping label image information stored in a database and transmitting the carrier's shipping label image information to the customer's computer. Although Williams does not disclose receiving at said interface system an image of a shipping label from said carrier computer system in response to said customer return service request, it would have been obvious to one of ordinary skill in the art at time the invention was made to have determined that information stored in a carrier database managed by the returns system and retrieved by the returns system in response to a customer returns request could be stored separately in databases managed by each carrier and retrieved over the communications network in response to a customer return request.

Please note: interpreting claim 1 as a whole, this particular step is of no consequence to the final outcome.

- and providing said shipping label image to at least one of said merchant computer system and said customer. Customer receives image of shipping label image from merchant to print (see at least Fig. 26; Fig. 27a; Fig. 27b; 0251-0292).
- Associate return destinations with customer return request: zip-to-zip shipping rate calculated based on Merchant supplied return destination and customer supplied address (see at least 0237); please note, merchant

system authorizes return which only occurs if authorized (see at least 0252-0253).

- Storing tracking number. (see at least 0148).
- Using XML. (see at least Fig. 51; Fig. 52; 0132).

**2. Claims 11 and 26 are rejected under 35 USC 103(a) as being unpatentable over Williams (US 2002/0032612) in view of Hauser (IDS entered 19 December 2006, with fee set forth and considered after prosecution of first action on the merits, US 6536659).**

Williams teaches all the above as noted under the 103(a) rejection and teaches the customer printing a return shipping label on their remotely connected client computer from the screen page provided by the returns system, but does not disclose the system transmitting the shipping label image to the customer via electronic mail. On the other hand, Hauser teaches an online merchandise returns system that also allows the customer to print a return shipping label and further teaches the Hauser system transmitting the shipping label to the customer via electronic mail (see at least abstract; col. 4, lines 15-35). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Williams to communicate a shipping label to the customer via electronic mail as taught by Hauser, for the system of Williams to provide an alternative way to communicate with the customer a shipping label.

***Conclusion***

Applicant's amendment to independent claims necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 19 December 2006 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

Art Unit: 3625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert M. Pond  
Primary Examiner  
March 2, 2007